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EXAMINER

HOLTON, STEVEN E

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVEN S. HOMER

Appeal 2009-004507
Application 10/814,538
Technology Center 2600

Decided: June 22, 2010

Before ROBERT E. NAPPI, JOHN C. MARTIN, and JOSEPH F.
RUGGIERO, *Administrative Patent Judges*.

RUGGIERO, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 from the Final Rejection of claims 1-8 and 17-21. Claims 9-16 have been allowed by the Examiner. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm-in-part.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Appeal Brief (filed November 16, 2007), the Answer (mailed April 15, 2008), and the Reply Brief (filed June 5, 2008) for the respective details. Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant could have made but chose not to make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

Appellant's Invention

Appellant's invention relates to a computer input pen having a cylindrical housing which includes an eccentrically disposed weight disposed relative to a longitudinal axis of the cylindrical housing. The rotational energy of the cylindrical housing relative to the weight is absorbed by the weight which is rotationally coupled relative to the cylindrical housing with a desired level of friction. (*See generally* Spec. ¶¶ [0002]-[0003]).

Claim 1 is illustrative of the invention and reads as follows:

1. A computer input pen, comprising:
a cylindrical housing; and
a weight eccentrically disposed within the cylindrical housing relative to a longitudinal axis of the cylindrical housing, the weight rotationally coupled relative to the cylindrical housing with a desired level of friction to absorb rotational energy of the cylindrical housing relative to the weight.

The Examiner's Rejection

The Examiner's Answer relies on the following prior art reference:

Danis US 6,215,480 B1 Apr. 10, 2001

Claims 1-8 and 17-21, all of the appealed claims stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Danis.

ISSUES

The pivotal issues before us are whether the Examiner erred in determining that an ordinarily skilled artisan would have found it obvious to

a) design the necessarily existing level of friction in the device of Danis to be as low as possible, and that this low level of friction would correspond to the desired level of friction as claimed, and

b) to reduce the amount of undesirable rotation of the sensor in Danis by adding a frictional element to the various surfaces to increase the amount of friction applied to the weighted cam or to allow friction between the housing and the weighted cam.

PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966) (stating that 35 U.S.C. § 103 leads to three basic factual inquiries: the scope and content of the prior

art, the differences between the prior art and the claims at issue, and the level of ordinary skill in the art). Furthermore,

‘there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.

KSR Int’l Co. v. Teleflex Inc., 550 U.S. 398, 418 (2007) (quoting *In re Kahn*, 441 F.3d 977, 987-988 (Fed. Cir. 2006)).

ANALYSIS

Claims 1, 4, 17, and 18

With respect to independent claim 1, Appellant’s arguments focus on the contention that Danis has no teaching or suggestion of the particular claimed relative coupling of the eccentrically disposed weight and the cylindrical housing of the computer input pen. In particular, Appellant contends (App. Br. 5-7 and 12-14; Reply Br. 4-8) that Danis has no teaching or suggestion of the weight in Danis being “rotationally coupled relative to the cylindrical housing with a desired level of friction to absorb rotational energy of the cylindrical housing relative to the weight” as claimed.

In Appellant’s view (App. Br. 6-7; Reply Br. 5), while the Examiner suggests that a low level of friction is the desired level of friction relative to the weighted cam 32 in Danis, there is no amount of friction in Danis that would be desired so that the weighted cam would freely rotate within the housing, thereby enabling accurate scrolling of text as the housing body 10

rolls. Appellant makes a similar argument with respect to independent claim 17 which is set forth in “means plus function” format.

We do not find Appellant’s argument to be persuasive of any error in the Examiner’s stated position. Initially, we agree with the Examiner’s determination (Ans. 5), which is not disputed by Appellant, that the rotational coupling of the weighted cam 32 and the housing 10 in Danis would necessarily have some level of friction relative to the weighted cam. With this in mind, we agree with the Examiner (*id.*) that an ordinarily skilled artisan would have recognized and appreciated the desire to design the level of friction in Danis to be as low as possible so that only a small amount of rotational energy is absorbed, thereby enabling the proper display of scrolled text. Since some level of friction necessarily exists in Danis, we fail to see why making such level of friction as low as possible would not result in this low level of friction being the desired level of friction as claimed.

For the above reasons, we sustain the Examiner’s 35 U.S.C. § 103(a) rejection of independent claims 1 and 17, as well as dependent claims 4 and 18 not separately argued by Appellant.

Claims 2, 3, 5-8, and 19-21

We do not sustain the Examiner’s obviousness rejection, based on Danis, of dependent claims 2, 3, 5-8, and 19-21. Each of these claims recites “a frictional element” or a “friction means” disposed on or formed on various surfaces of the computer input pen such as the eccentrically disposed weight, the cylindrical housing, or the shaft to which the weight is rotationally coupled.

As previously discussed, the Examiner has taken the position, with which we agree, with respect to claims 1, 4, 17, and 18 that, because of the naturally existing level of friction relative to the weighted cam in Danis, it would be desirable to make this level of friction in Danis as low as possible to enable proper display of scrolled text. The Examiner, however, has taken a contradictory position (Ans. 6) with respect to claims 2, 3, 5-8, and 19-21 by suggesting that extremely low levels of friction are undesirable and would result in unwanted changing of the displayed text in Danis due to the extra rotation of the sensor. In this viewpoint, the Examiner suggests that it would be desirable to reduce the amount of undesirable rotation of the sensor in Danis by adding a frictional element to the various surfaces to increase the amount of friction applied to the weighted cam or to allow friction between the housing and the weighted cam.

We find no basis on the record before us to support the Examiner's conclusion. We agree with Appellant (App. Br. 7-8; Reply Br. 8) that the inclusion of any friction element to add friction beyond that which naturally occurs in Danis would impede the rotation of the cam 32 and affect the ability of the sensor 31 to accurately detect the speed and direction of rotation of the cylindrical housing body 10.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner's obviousness rejection based on Danis was not in error with respect to claims 1, 4, 17, and 18, but was in error with respect to claims 2, 3, 5-8, and 19-21.

DECISION

The Examiner's decision rejecting claims 1-8 and 17-21 under 35 U.S.C. § 103(a) is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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